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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,576	07/27/2001	Noriko Yagi	1403-0214P	8192

2292 7590 02/26/2004

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EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/915,576

Applicant(s)

YAGI ET AL.

Examiner

Katarzyna Wyrozebski Lee

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 February 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment to the advisory.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,3,4 and 6.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Katarzyna Wyrozebski Lee
Primary Examiner
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Attachment to the Advisory

Applicant's request for reconsideration has been considered. It is examiner's position that the prior art of record as applied against present claims is very much applicable and applicant's arguments will be addressed below:

a) The applicants argued on page 5 of the request that the particle size of the clay component of primary reference of STUHL DREHER has medium particle size of about 0.2 microns whereas present invention requires particle size to be in a range of 0.5-10 microns.

With respect to the above argument, for the second time the examiner would like to point out that the prior art of STUHL DREHER teaches particle size of not about 0.2 microns but from 0.2 microns. Terms "about" asserted by the applicant and "from" actually disclosed in STUHL DREHER are two entirely different terms. "from" encompasses amounts of 0.2 microns and higher.

b) The prior art of FUKUMOTO, which is secondary reference utilized in the pending rejection since working examples SBR and silica are not utilized and furthermore since total amount of silica and clay is at most 30 pbw.

Two, things, the prior art of FUKUMOTO was utilized to provide for clay particle size that is commonly utilized in the tire tread and this is what applicants claim, a composition for tire

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tread. The examiner stated in the office action that it would be obvious to use the clay of FUKUMOTO in the composition of STUHLBREHER. The rejection was targeted to rubber or silica.

Secondly, even if the silica and rubber were the main reason for the rejection (which they are not) the examiner cannot limit its rejection to the examples alone but has to consider the entire prior art disclosure.

c) The reference of HERGENROTHER does not teach clay component having particle size of 0.5-10 microns and therefore cannot possibly contemplate the present invention.

With respect to the above argument, the examiner would like to point the applicants to the first office action on the merits. The rejection written is actually that of HERGENROTHER in view of FUKUMOTO.

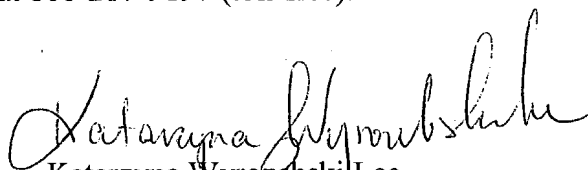
In view of the above, the rejections over the prior art of record are not overcome and are incorporated here by reference.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski Lee whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Katarzyna Wyrozebski Lee
Primary Examiner
Art Unit 1714

kiwl
February 24, 2004